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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/790,687 | 03/03/2004 | Ezio Musso | 108910-00123 | 2294 |

4372 7590 02/15/2006

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EXAMINER

SERGEANT, RABON A

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| ART UNIT | PAPER NUMBER |
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1711

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,687

Applicant(s)

MUSSO ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/375,239.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. In view of the arguments within applicants' response of January 27, 2006, the previous Office action has been modified to include an additional grounds of rejection under 35 USC 103. The finality of the previous Office action has been withdrawn.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-4, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Klug et al. ('882 or '016 or '931).

Patentees disclose azeotropic compositions and their use as blowing agents for polyurethane foams, wherein compositions that correspond to applicants' compositions are

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disclosed. See abstracts. Since azeotropic compositions are disclosed, applicants' percent compositions are considered to be inherently met by the references.

4. Applicants' response has been considered; however, the formulas within the abstract and specification encompass the claimed fluoroether blowing agent and the claimed hydrofluorocarbon blowing agents. Contrary to applicants' assertion, the teachings of the references are not limited to the specifically recited compounds recited within the references.

5. Claims 1-4, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klug et al. ('882 or '016 or '931).

Patentees disclose azeotropic compositions and their use as blowing agents for polyurethane foams, wherein applicants' claimed compounds of the claimed composition are encompassed by the disclosed formulas for the components of the disclosed azeotropic composition. See abstracts. Since azeotropic compositions are disclosed, applicants' percent compositions are considered to be met by the references. Though patentees fail to specifically exemplify applicants' claimed component species, the position is taken in view of the disclosures of the prior art that it would have been obvious to select a fluoroether and a hydrofluorocarbon that satisfy the conditions of the aforementioned formulas and to utilize the resulting azeotropic blend in its art recognized capacity as a blowing agent for the production of polyurethane foam. The position is additionally taken that controlling the density of the foam to arrive at a certain or specific density value amounts only to the control or optimization of result effective variables.

In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klug et al. ('882 or '016 or '931) in view of Barthelemy et al. ('320).

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As aforementioned, Klug et al. are considered to disclose azeotropic compositions and their use as blowing agents for polyurethane foams that at the least render obvious applicants' azeotropic composition and their method for producing a polyurethane foam. However, while Klug et al. are silent regarding the use of additional blowing agents, such as water or carbon dioxide, within polyurethane foam formulations, the use of water in combination with fluoroether azeotropes as blowing agents for polyurethane foams was known at the time of invention. This position is supported by the teachings of Barthelemy et al. ('320). See Table III. Therefore, the position is taken that it would have been obvious to utilize water and carbon dioxide (inherently generated by the use of the water blowing agent) as additional blowing agents with the foam formulations of Klug et al. so as to arrive at the instant invention.

7. Applicants' declaration, filed August 17, 2005, has again been considered; however, the declaration is insufficient to overcome the prior art rejections for the following reasons. Firstly, the example of the declaration is not commensurate in scope with the claims, with respect to species of components or quantities of components. Secondly, it is by no means clear that applicants' results are unexpected. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. *In re Reese*, 129 USPQ 402. Furthermore, regarding applicants' showings that other blowing compositions yield unsuitable foams, the position is taken that it is to be presumed that skilled workers would as a matter of course, if they do not immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker; therefore, the failures of experimenters who have no interest in succeeding should not be accorded great weight. *In re Michalek*, 162 F.2d 229, 74 USPQ 107


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(CCPA 1947); *In re Reid*, 179 F.2d 998, 84 USPQ 478 (CCPA 1950). It is not seen that applicants' response has addressed these deficiencies of the declaration.

8. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
February 9, 2006


RABON SERGENT
PRIMARY EXAMINER